

REMARKS

In response to the Office Action mailed October 12, 2005, Applicants have amended claims 1, 6, 11, 14, 17, 21-23, 25, 27-34, 37, 39-41, 44, 49, 54, 57, 60, 64-66, 68, 70, 71, 73, 74, 76, 77, 80, 82-85, and 87-100 to correct minor typographic errors and recite features inherent in the original words of the claims and cancelled claims 43 and 86 without prejudice or disclaimer. Claims 1-42, 44-85, and 87-100 are pending. Applicants have also amended the specification to correct a typographical error introduced by the Office in the published application.

In the Office Action, the Examiner rejected claims 1-20, 44-63, and 87-98 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5, 387,783 to Mihm et al. ("*Mihm*") and rejected claims 21-43, 64-86, and 99-100 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,648,916 to Manduley ("*Manduley*"). For the reasons stated below, Applicants traverse these rejections.

In order to properly anticipate claims 1-42, 44-85, and 87-100 under 35 U.S.C. § 102, the cited reference must explicitly disclose each and every limitation recited in the claims. See M.P.E.P. § 2131 (8th ed., August 2005 rev.). If the reference, however, fails to expressly set forth a particular limitation, then the Examiner must show that this limitation is inherently disclosed to substantiate a claim of anticipation. See *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). To establish inherency, the Examiner must specifically identify extrinsic evidence that makes clear to one skilled in the art that the missing limitation "is necessarily present" in the reference's disclosure. See *id.*; see also *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

Mihm does not disclose each and every limitation recited in claims 1-20, 44-63, and 87-98. For example, claim 1 recites, among other things, "a user with an electronic

account of the user,” and “linking the standardized physical address to the electronic account,” and *Mihm* does not teach or suggest at least these recited features.

Instead, *Mihm* discloses a system for determining and inserting a barcode representing a ZIP Code™ delivery code into a printed word processing document, such as a letter or envelope. (E.g., abstract, col. 1, lines 10-18, col. 2, lines 22-31; col. 3, lines 59-65; col. 6, lines 22-29; etc.). The *Mihm* system simply receives a word processing file (col. 10, lines 8-14), searches for address information in the file (col. 10, line 15 - col. 11, line 13), looks up a ZIP Code™ delivery code corresponding to the address (col. 11, line 14 - col. 12, line 10), and inserts barcode information representing the ZIP Code™ delivery code into the file (col. 12, lines 11-22), which will cause a printer to print the bar code along with the rest of the information in the file (col. 12, lines 23-38). *Mihm* discloses nothing related to an electronic account of a user or linking a standardized physical address to the electronic account of the user, as recited in claim 1, because the *Mihm* system merely adds ZIP Code™ barcodes to documents that are being sent to a printer.

Moreover, many of the independent claims recite additional features not taught or suggested by *Mihm*. For example, *Mihn* does not teach or suggest “a delivery point identification key,” as recited in independent claims 6, 11, 14, 17, 49, 54, 57, 60, 88-91, and 95-98.

For at least the forgoing reasons, *Mihm* does not disclose each and every limitation recited in independent claim 1. Claim 1 is therefore not anticipated by *Mihm*, and this claim is allowable. Similarly, for at least the same reasons, *Mihm* does not anticipate independent claims 6, 11, 14, 17, 44, 49, 54, 57, 60, and 87-98, which recite

similar features as those of claim 1, and these claims are allowable. In addition, claims 2-5, 7-10, 12, 13, 15, 16, 45-48, 50-53, 55, 56, 58, and 59 are allowable at least by virtue of depending from allowable base claims.

In the Office Action, the Examiner rejected pending claims 21-42, 64-85, and 99-100 under 35 U.S.C. § 102(e) as being anticipated by *Manduley*. Applicants traverse because *Manduley* does not disclose each and every limitation recited in claims 21-42, 64-85, and 99-100. For example, independent claim 21 recites, among other things, “an electronic account including a physical address and an electronic address,” “determining an electronic address for each user of the plurality of users from the physical address of each user using the electronic account of each user,” and “sending the message in an electronic format to the electronic address for each user of the plurality of users.” *Manduley* does not teach or suggest at least these recited features.

Instead, *Manduley* discloses a system for scanning hard copy paper mail that was mailed to a single address (e.g., a company’s building) into electronic form and emailing the scanned file to a person at that address. (Abstract, col. 1, lines 47-54; col. 2, lines 20-41; col. 3, lines 1-5). *Manduley* also discloses conventional email handling for email received by the company. (Col. 3, lines 16-19).

Manduley contains no teachings or suggestion regarding an electronic account of a user including a physical address and an electronic address, as recited in claim 21, because *Manduley*’s system does not convert between the two. *Manduley*’s system does not and cannot determine an electronic address for each user of the plurality of users from the physical address of each user using the electronic account of each user, as recited in claim 21, because all the user’s in the *Manduley* system have the same

physical address--namely the address of the building they work in--and the electronically scanned letters are routed internally based on the name of the individual to whom the mail is address. (Col. 2, lines 20-28). Moreover, *Manduley's* system does not have any teachings regarding "sending the message in an electronic format to the electronic address for each user of the plurality of users" because it delivers only single scanned-in mail items to single individuals. *Manduley's* system is not designed to send the same message to "each user of a plurality of users," as recited in claim 21.

For at least the forgoing reasons, *Manduley* does not disclose each and every limitation recited in independent claim 21. Claim 21 is therefore not anticipated by *Manduley*, and this claim is allowable. Similarly, for at least the same reasons, *Mihm* does not anticipate independent claims 34, 64, 77, 99, and 100, which recite similar features as those of claim 21, and these claims are also allowable. In addition, claims 22-33, 35-42, 65-76, and 78-85 are allowable at least by virtue of depending from allowable base claims.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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